

In re HAIMOVSKY ET AL., Application No. 10/042,846
Amendment A

REMARKS

The Office action dated November 10, 2004, and the references cited have been fully considered. In response, please enter the amendments presented herein and consider the following remarks. Reconsideration and/or further prosecution of the application is respectfully requested. No new matter is added herein.

Applicants appreciate the Office considering the references and returning the signed and dated 1149.

The following will discuss the amendments to the claims.

Applicants appreciate the Office noticing the typographical errors and making the suggestions for correction. The amendments to claims 2, 8, 22, and 16 include these suggested amendments. Applicants therefore request these claim objections be withdrawn.

Independent claim 8 is amended to include the limitations: "wherein the master system is configured to perform one or more operations to identify the first slave system and the second slave system after the master system is booted and the first and second slave systems are released, and in response, to determine that the first remote boot image should be used for the first slave system and that the second remote boot image should be used for the second slave system, and to update the first programmable interface to retrieve the first remote boot image, and to update the second programmable interface to retrieve the second remote boot image." Support for such amendment is provided at least by FIG. 2 and its corresponding discussion on pages 12 and 13 of the originally filed specification. As no reference of record performs such operation nor any such teaching of performing operations to identifying a slave system and then to redirect it to its boot in response to such dynamic identification, independent claim 8 and its dependent claims of 9-12 and 30-32 are also believed to be allowable. Note, support for new claims 30-32 is provided at least by the discussion on page 12, lines 11-20 of the original application. For at least these reasons, claims 8-12 and 30-32 are believed to be allowable.

Independent claims 13 and 24 are amended in roughly the same manner as independent claim 8 (the exact limitation is recited in the claims themselves), and therefore support for these

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amendments is provided as discussed, and for the same reasons, independent claim 13 and its dependent claims of 14-17 and 33, and independent claim 24 and its dependent claims 25-27 and 34 are believed to be allowable. Note, support for new claims 33 and 34 is provided at least by the discussion on page 12, lines 11-20 of the original application.

Finally, claims 28, 29, 23, 28 and 29 are cancelled herein to free up claim fees for the newly added claims.

As to the rejections of independent claim 1 and its dependent claims of 2-7, and independent claim 20 and its dependent claims 21 and 22, the following remarks are numbered to reference the same numbered paragraphs of the Office Action to which they are directed.

Paragraphs 4-10. Claims 1-3 and 20-22 stand rejected under 35 USC § 102(b) as being anticipated by Rahman et al., US Patent 5,539,890. Applicants respectfully traverse these rejections as Rahman et al. neither teaches nor suggests all the limitations as required by the MPEP for a proper rejection, and therefore Applicants respectfully request all rejections be withdrawn. Note, if the Office action complies with MPEP § 706 and 37 CFR 1.104(c)(2), then Rahman et al., the reference relied upon in rejecting the claims, is the best prior art reference available. As Rahman et al. fails to teach all the claim limitations, then claims 1-3 and 20-22 are believed to be allowable over the best prior art available, and Applicants request the claims be allowed.

For anticipation under 35 USC § 102, the reference *must teach each and every aspect of the claimed invention* either explicitly or impliedly, and the burden is on the Office to present a *prima facie* case of anticipation. MPEP § 706.02. Inherent means it *must* occur. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP § 2112 (*emphasis in original*).

Rahman et al. is directed to a single system with two microprocessor that run in tandem for reliability purposes. Abstract. In fact, Rahman et al. explicitly teaches that FIG. 1 (that relied

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upon by the Office) is a processor system 10 comprising two microprocessors 12(0,1). Col. 2., ll. 42-53. This neither teaches nor suggest two systems, i.e., a master system and a slave system as recited in claim 1, and as required by the MPEP for a proper anticipation rejection. Moreover, the Office of its own volition selectively groups (similar to gerrymandering) items based on the claim elements/limitations what is in one system with microprocessor 12(0) and what is as second system with microprocessor 12(1), rather than relying on the teachings of the reference as required by the MPEP. For anticipation, the teaching must be in the reference. Even if the Office attempts to rely on "a broad interpretation of the pending claims," the reference still must teach what components are in which of the two systems as applied by the Office, which it doesn't, and in fact, would be inconsistent with the purpose of Rahman et al., which is to have a single reliable, tandem system including two microprocessors.

For at least these reasons, the Office fails to establish a *prima facie* case of obviousness (as required by the MPEP) for independent claim 1 and its dependent claims 2-7.

This rational also applies to claims 20-22. For example, independent claim 1 requires a remote system, and clearly Rahman et al. neither teaches nor suggests that one microprocessor is remote from the other microprocessor, in fact, it teaches the opposite. Moreover, claim 21 recites that the means for redirecting and means for storing are included in separate systems of the apparatus. Moreover, claim 22 recites a limitation of a file server, whereby the Office states that this limitation is met by memory 22. However, memory 22 is just a memory device, it has no file serving functionality.

For at least these reasons, the Office fails to establish a *prima facie* case of obviousness (as required by the MPEP) for independent claim 20 and its dependent claims 21-22.

Paragraphs 22-27. Dependent claims 4, 5, and 7 of claim 1 are rejected under 35 USC § 103(a) as being unpatentable over Rahman et al., in view of Haigh et al., US Patent Application Publication 2002/0087854.

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First, claims 4, 5 and 7 are believed to be allowable for at least the reasons presented for allowance of independent claim 1.

Next, for obviousness under 35 USC § 103(a) requires "the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP § 706.02(j) (*citing In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991))(emphasis added). And, the burden is on the Office Action to establish a *prima facie* case of obviousness.

In order to meet this burden, the Office must at least present a rejection for each and every claim limitation, with these limitations being construed in light of the specification; all of *the presented rejections for a claim must be used in a consistent and as a whole cohere*; and the application of the reference(s) must teach the claim limitation to which it is/they are applied.

First, claim 4 recites that the programmable interface includes the system controller. The Office equates BMI 230 to the programmable interface and equates code 218 as the system controller. FIG. 2 of Haigh et al. clearly shows that BMI 230 does not include code 218. For at least this additional reason, the Office has failed to present a rejection for each and every claim limitation as required by the MPEP. Moreover, the Office must show the motivation and expectation of success to modify PIC 16 of Rahman et al. to include the missing limitations for a coherent rejection and per MPEP § 2143.01.

Moreover, there must be a causational rational or motivation to make such a combination in the references themselves, and not relying on Applicants disclosure nor claims for providing the blueprint or recipe for such a combination. The Office states that its presented combination was motivated "to reduce overhead and maintenance in a network system." Applicants do not see how one skilled in the art wanting ""to reduce overhead and maintenance in a network system" would come up with modify PIC 16 and redesigning the remote boot mechanism in such a manner as to read upon all the claim limitations. Rather, the Office apparently relies on

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Applicants' claims as recipes for selecting pieces of art, rather than the stated and specious motivation of making a better system as reason to combining these references.

Moreover, claim 5 is believed to be allowable for at least these reasons. Additionally, the Office relies on BMI Device Driver 228 for the master system controller being programmed by the master system for redirecting the boot image retrieval request. However, Haigh et al. teaches, in paragraph 27, that BMI Device Driver 228 passes on received commands. It performs no such redirection. Additionally, the Office fails to provide a motivation for adding these additional functions of Haigh et al. to the system of Rahman et al. as required by MPEP 2143.01.

Additionally, claim 7 is believed allowable for at least the reasons presented for allowance of claim 1. Moreover, the Office fails to present a proper § 103 rejection in compliance with MPEP § 706.02(j).

Paragraphs 28-31. Dependent claim 6 is rejected under 35 USC § 103(a) as being unpatentable over Rahman et al., in view of Jones et al., US Patent 6,757,759.

First, dependent claim 6 is believed to be allowable for at least the reasons presented for independent claim 1. Moreover, Applicants respectfully traverse the rejection of claim 6, as the Office fails to present a coherent *prima facie* case of obvious. Based on antecedent basis, the storage system includes the remote boot image, and thus, Jones et al.'s second slave system would need to include the remoter boot image. The Office states the motivation of combination of references is because it "provides a way to run multiple concurrent operations." Again, the Office apparently relies on Applicants' claims as recipes for selecting pieces of art, rather than the stated and specious motivation of making a better system as reason to combining these references. Also, there must be a reasonable expectation of success, and the Office fails to present a teaching on how to modify PIC to use the storage in Jones et al.'s second slave system to allow it to work.

For at least these reasons, Applicants respectfully request the rejections be withdrawn, and claims 1-7 be allowed, especially if the Office action complies with MPEP § 706 and

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37 CFR 1.104(c)(2), then the references relied upon in rejecting the claims are the best prior art references available, and alone, or in combination, they neither teach nor suggest all the claim limitations.

FINAL REMARKS. In view of the above remarks and for at least the reasons presented herein, all pending claims are believed to be allowable over the prior art of record, the application is considered in good and proper form for allowance, and the Office is respectfully requested to issue a timely Notice of allowance in this case. If, in the opinion of the Office, a telephone conference would expedite the prosecution of the subject application, the Office is invited to call the undersigned attorney.

Applicants believe a one-month extension of time is required, and hereby petitions any extension of time required and has included herewith a credit card payment form (PTO-2038) for payment of the extension fee, and Applicants hereby authorize the Commissioner to charge/credit any additional associated fees to Deposit Account No. 501430.

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Additionally, the Commissioner is hereby generally authorized under 37 C.F.R. § 1.136(a)(3) to treat this communication or any future communication in this or any related application filed pursuant to 37 C.F.R. § 1.53 requiring an extension of time as incorporating a request therefore, and the Commissioner is hereby specifically authorized to charge Deposit Account No. 501430 for any fee that may be due in connection with such a request for an extension of time. Moreover, the Commissioner is hereby authorized to charge payment of any fee due any under 37 C.F.R. §§ 1.16 and § 1.17 associated with this communication or any future communication in this or any related application filed pursuant to 37 C.F.R. § 1.53 or credit any overpayment to Deposit Account No. 501430.

Respectfully submitted,
The Law Office of Kirk D. Williams

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By



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